

5/11/01

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF  
THE TTAB

Paper No. 9  
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Premier Internet Corporation

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Serial No. 75/599,648

Andrew N. Spivak of Morrison & Foerster LLP  
for Premier Internet Corporation.

Henry S. Zak, Trademark Examining Attorney, Law Office 108  
(David Shallant, Managing Attorney).

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Before Simms, Hairston and Wendel, Administrative Trademark  
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Premier Internet Corporation has filed an application  
to register the mark NEWSBREAKER for "news delivery  
services, namely, providing news and information via a  
global computer network."<sup>1</sup>

Registration has been finally refused under Section  
2(e)(1) of the Trademark Act on the ground that the mark,  
when used in connection with the recited services, is

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<sup>1</sup> Serial No. 75/599,648, filed December 4, 1998, claiming a first  
use and first use in commerce date of September 18, 1998.

merely descriptive thereof. The refusal has been appealed and applicant and the Examining Attorney have filed briefs.<sup>2</sup> An oral hearing was not requested.

The Examining Attorney maintains that the term NEWSBREAKER merely describes a feature of applicant's on-line news delivery services in two contexts, either as a descriptor of the nature of the stories provided (newsbreaking stories or newsbreakers) or as a descriptor of the nature of the entity providing these stories (an organization delivering newsbreaking stories or a newsbreaker).

Looking to the specimens of record, the Examining Attorney quotes the following language used in describing the contents of the NEWSBREAKER NEWS:

A New Concept in News for Santa Monica

Newsbreaker News Service in Santa Monica will bring you everything, and more, than is offered by any other local media. We will have a daily editorial, feature stories, columnists, local news events.

From these statements, the Examining Attorney contends, that the "news delivery services" of applicant appear to be no different in content than any other type of media which provides newsworthy material to the community. He argues

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<sup>2</sup> The application was reassigned to a new Examining Attorney for preparation of the brief.

that the applicant is simply offering an "alternative news source, rendered via an electronic computer network."

With this background, the Examining Attorney maintains that the term "newsbreaker" has particular significance when used in connection with news reporting or delivery services. He argues that a first descriptive meaning for the term is as an identifier of stories of particular news interest. He relies upon the following excerpts from NEXIS articles, selected from those made of record by the prior Examining Attorney, to demonstrate this connotation:

We were given the inside tract on that newsbreaker during the 30<sup>th</sup> Annual New York State Outdoors Writers Association's spring conference ...  
*The Times Union* (May 21, 1997);

Nike's regeneration of the 'Just Do It' campaign is another recent newsbreaker.  
*SportStyle* (April 1995);

This is the first, however, devoted to a selection of the anonymous "Notes and Comments," "Talk of the Town" pieces and newsbreakers he composed for the magazine  
*The Times Union* (January 27, 1994).

He argues that the term "newsbreaker," within this meaning, would describe a feature or characteristic of applicant's services in that it describes the type of stories delivered by applicant, namely, "newsbreaking stories of interest to the local community or newsbreakers."

The second meaning of the term "newsbreaker" which the Examining Attorney contends is applicable to applicant's

news delivery services is the use of the term to identify the source or provider of newsbreaking stories. He relies upon the following excerpts to demonstrate this usage:

The tabloid format was necessitated by PennWell positioning the new publication as a newsbreaker within the market...

*min's b-to-b* (December 21, 1998);

On the tech side, online newsbreakers like C/Net and ZDNet continue to encroaching [sic] on the magazine's traditional space...

*Marketing Computers* (June 1997);

And while every edition of "Frontline" is not a distinctive newsbreaker, the series hits more often than it misses.

*The Boston Herald* (October 24, 1995).

Given this meaning for "newsbreaker", the Examining Attorney maintains that the term would be merely descriptive of a feature or characteristic of applicant itself, namely, as an organization which delivers news breaking news. This descriptive significance, he argues, would carry over to the news delivery services offered by applicant.

Applicant strongly contests the probative value of the NEXIS evidence being relied upon by the Examining Attorney. Noting that of the 147 "hits" obtained by the Examining Attorney only 18 of the articles have been made of record, applicant contends that most usages even in these articles are not applicable to applicant's particular services.

Applicant points to stories in which "Newsbreakers" is used as the title of a television show, to the name of an award, or to a publication or particular person labeled as being a "newsbreaker," in that this is one which, or who, "breaks" the news.<sup>3</sup> Applicant insists that it merely delivers news of others via the computer and that its computer services do not involve sending reporters into the field or any news "breaking." Applicant argues that consumers would not consider the mark descriptive of applicant's delivery services, since news delivery providers are not viewed as those "breaking the news." Applicant asserts that it is the particular media programs, publications and individuals that create and "break" news stories, whereas entities such as applicant simply deliver such stories. Thus, applicant contends, NEWSBREAKER is no more than suggestive of its computerized news delivery services.

In addition, applicant points out that its copending application for the mark NEWSBREAKER for "computer software for the display of moving or static text, multiple images, and statistical evidence and information in a global computer information network, local and wide area computer

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<sup>3</sup> The fact that applicant has ascertained that many of the articles not relied upon by the Examining Attorney refer to a race horse named Newsbreaker is totally irrelevant to the issue before us.

networks" has been allowed to register by the Office. Applicant argues that, since the subject matter of this software is essentially the same as that of applicant's news delivery services, the registration is strong evidence that that present application should also be passed to registration.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic or feature of the goods or services with which it is being used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Whether or not a particular term is merely descriptive is determined not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the designation is being used, and the significance the designation is likely to have to the average purchaser as he or she encounters the goods or services bearing the designation, because of the manner in which it is used. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary that the term or phrase describe all the characteristics or features of the goods or services in order to be merely descriptive; it is sufficient if the term or phrase describes one significant attribute thereof.

See In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991).

From the evidence of record we see that the term "newsbreaker" has several nuances in meaning.<sup>4</sup> Nonetheless, it is clear that, although often used in reference to the persons or entities which "break" news stories, the term may also be used to refer to the type of news story itself. Thus, even if we accept the limitation that applicant merely delivers the news gathered by others, applicant may, and most likely does, still deliver "newsbreaking" news or "newbreakers." Clearly, the title shown on the website page submitted as a specimen, NEWSBREAKER NEWS, creates such an inference and is indicative of the reaction that consumers would have to the mark. See In re Pharmaceutical Innovations, Inc., 217 USPQ 365 (TTAB 1983)(evidence of context in which an applicant is using the mark is probative of the reaction of purchasers to the mark.)

Thus, we agree with the Examining Attorney that the term NEWSBREAKER merely describes a feature or characteristic of applicant's news delivery services, namely, that these are "newsbreaking" stories or

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<sup>4</sup> We find the number of excerpts relied upon by the Examining Attorney fully adequate to establish the various connotations of the term.

"newsbreakers." Even if stories are garnered by others, it is applicant who passes along this type of news to the general public.

Furthermore, there is no restriction in the recitation of services that the news which applicant provides is gathered solely by others. Applicant has provided no evidence to substantiate its claim that a news delivery service would be so limited. Thus, even the connotation of a "newsbreaker" as one who actually "breaks" the news is not inapplicable to applicant's news delivery services. At the very least, we agree with the Examining Attorney that the term "newsbreaker" would be equally descriptive of applicant as an organization which delivers "newsbreaking news," whether gathered internally or by outside sources. If applicant can aptly be described as an organization providing a "newbreaking" service, its news delivery services can well be described as being those of a "newbreaker." <sup>5</sup>

Accordingly, we find the term NEWSBREAKER, when used in connection with news delivery services for providing news and information via a global computer network, merely descriptive thereof. The fact that applicant may have

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<sup>5</sup> We note the particular NEXIS article in which reference is specifically made to "online newsbreakers."



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obtained a registration for the same term when used in connection with computer software products does not alter our decision. The descriptiveness of the term NEWSBREAKER in connection with a news delivery service is the issue here, not in connection with computer software products which may be used in the implementation of this service.

Decision: The refusal to register under Section 2(e)(1) is affirmed.